



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/615,219	07/07/2003	John R. Klug	11060.01	8667

20686 7590 06/30/2005

DORSEY & WHITNEY, LLP
INTELLECTUAL PROPERTY DEPARTMENT
370 SEVENTEENTH STREET
SUITE 4700
DENVER, CO 80202-5647

EXAMINER

NGUYEN, PHUOC H

ART UNIT PAPER NUMBER

2143

DATE MAILED: 06/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/615,219

Applicant(s)

KLUG ET AL.

Examiner

Phuoc H. Nguyen

Art Unit

2143

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>7/7/03 & 4/16/04</u> . | 6) <input type="checkbox"/> Other: _____ |

KL

20

DETAILED ACTION

Response to Amendment

1. This office action is in response to the amendment filed on March 22, 2005. Previous office action contained claims 1-8. Applicant amended claims 1 and 6; and added claims 9-29. Amendment filed on March 22, 2005 have been entered and made of record. Therefore, pending claims 1-29 is presented for further consideration and examination.

Response to Arguments

2. Applicant's arguments with respect to claim 1 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-29 are rejected under 35 U.S.C. 102(e) as being anticipated by Servan-Schreiber et al. (Hereafter, Servan-Schreiber) U.S. Patent 6,892,354.

5. Regarding claim 1, Servan-Schreiber discloses a system for providing node targeted content in an addressable network (Abstract), comprising: an access request receipt module (Abstract); a module configured to provide information in response to the access request, and a

module configured to present at least one message (e.g. advertisement(s)) displayed prior to completing display of the information and based upon an expected time period (e.g. idle time) (col. 1 lines 50-67; and col. 2 lines 60-65).

6. Regarding claim 2, Servan-Schreiber further discloses a user profile containing user information, and a base message set from which the at least one message is chosen, wherein the choice of the message is based on the user information (col. 4 lines 50-60).

7. Regarding claim 3, Servan-Schreiber further discloses a first transmission module operative to transmit the information, and a second transmission module operative to transmit the at least one message (col. 2 lines 60-65).

8. Regarding claim 4, Servan-Schreiber further discloses the second transmission module is further operative to transmit the entirety of the base message set prior to the transmission module transmitting the information (col. 3 last paragraph).

9. Regarding claim 5, Servan-Schreiber further discloses the second transmission module transmits the at least one message during transmission of the information by the first transmission module (col. 3 2nd paragraph).

10. Regarding claim 6, Servan-Schreiber further discloses the first and second transmission modules are the same (col. 3 last paragraph).

11. Regarding claim 7, Servan-Schreiber further discloses the message is an advertisement (col. 1 lines 58-63).

12. Regarding claim 8, Servan-Schreiber further discloses the user information is specified by a user, the access request receipt module is located at a first site of the addressable network,

the user profile is stored in a database, and the database is located at a second site of the addressable network (col. 4 lines 24-60).

13. Regarding claim 9, Servan-Schreiber discloses a system for providing node targeted content in an addressable network (Abstract), comprising: a web browser configured to receive and communicate a request to connect with a network node identified by a uniform resource locator and in response thereto to receive and present information provided by the network node (Figures 1 and 2); and a first module configured to determine a time period (e.g. idle time) available for presenting one or more messages (e.g. advertisement(s)), and a second module configured to present at least one message during the time period (col. 2 lines 66 through col. 3 2nd paragraphs).

14. Regarding claim 10, Servan-Schreiber further discloses the time period further comprises a quantity of time needed for the web browser to establish the connection with the network node and to retrieve and present a viewable portion of the information (col. 2 last paragraph through col. 3 1st paragraph).

15. Regarding claims 11-13, Servan-Schreiber further discloses the time period is predetermined, indefinite, less than an amount of time necessary for the web browser to request, retrieve and present a first frame of information formatted using hyper text markup language (col. 3 2nd paragraph; and col. 4 lines 24-41).

16. Regarding claims 14-15, Servan-Schreiber further discloses the message is terminated upon expiration of the time period, and the message is terminated prior to expiration of the time period and in conjunction with the presentation of at least a portion of the retrieved information (col. 3 2nd paragraph; and col. 4 lines 24-41).

17. Regarding claim 16, Servan-Schreiber further discloses at least one message is selected based upon the time period available (col. 3 2nd paragraph; and col. 4 lines 24-41).

18. Regarding claim 17, Servan-Schreiber further discloses the at least one message is selected based upon a user profile (col. 4 lines 51-60).

19. Regarding claim 18, Servan-Schreiber further discloses user profile is stored at a node remote to the web browser (col. 4 lines 51-60).

20. Regarding claim 19, Servan-Schreiber further discloses the user profile is derived from Internet usage (col. 4 lines 51-60).

21. Regarding claim 20, Servan-Schreiber further discloses the message presented is selected based upon the amount of the information provided by the network node (col. 4 lines 42-60).

22. Regarding claim 21, Servan-Schreiber discloses a method for providing one or more messages to an Internet user, during an Internet session, (Figures 1 and 2) comprising: receiving a request from an Internet user, during a current Internet session, to establish a connection with a first Internet site, the request including an address identifying content available from an Internet site (Figures 1 and 2); estimating a first time period (e.g. idle time) necessary to retrieve the content from the Internet site, identifying a message to present to the Internet user, presenting the message during at least a portion of the first time period (col. 2 lines 66 through col. 3 2nd paragraphs).

23. Regarding claim 22, Servan-Schreiber further discloses the message is presented for a second time period, the second time period being longer than the first time period (col. 4 lines 33-38).

24. Regarding claim 23, Servan-Schreiber further discloses the message is identified based upon a user profile (col. 4 lines 51-60).

25. Regarding claim 24, Servan-Schreiber further discloses the content is retrieved using at least one of the file transfer protocol and the hypertext transfer protocol (col. 2 lines 60-65).

26. Regarding claim 25, Servan-Schreiber further discloses the message is obtained from a local data store (e.g. user cache) established during a previous Internet session (col. 3 lines 59-65).

27. Regarding claims 26-27, Servan-Schreiber further discloses receiving an election that the Internet user desires to receive the message, and receiving an indication that the Internet user does not desire to receive the message (e.g. the election or indication the user decide receive the message or not is based upon the decision making by user such as user clicks or zooms to a specific content space of the web page, col. 4 lines 61 through col. 5 1st paragraph).

28. Regarding claims 28-29, Servan-Schreiber further discloses the message is presented during a loading time of the content and is terminated based upon a loading state, and the loading state is user specified (col. 3 2nd paragraph; and col. 4 lines 24-41).

Conclusion

29. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Hill U.S. Patent 5,805,815

Klug et al. U.S. Patent 5,996,007

Jones et al. U.S. Patent 6,792,445

Davis et al. U.S. Patent 5,796,952

30. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phuoc H. Nguyen whose telephone number is 571-272-3919. The examiner can normally be reached on Monday - Friday.

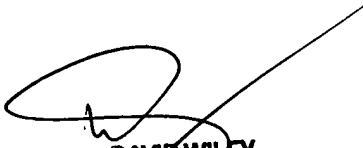
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley can be reached on 571-272-3923. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2143

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Phuoc H Nguyen
Examiner
Art Unit 2143

June 21, 2005



DAVID WILEY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100